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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/507,322

06/21/2005

Hugh Semple Munro

0021.0002

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07/09/2008

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EXAMINER

ZEMEL, IRINA SOPHIA

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/507,322	Applicant(s) MUNRO ET AL.	
	Examiner Irina S. Zemel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-55, 69-72 and 81-84 is/are pending in the application.
- 4a) Of the above claim(s) 47, 48 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-46, 49, 51-55, 69-72 and 81-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9-30-2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of 2-acrylamido-2-methylpropane sulphonic acid in the reply filed on 4-1-2008 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the examiner to examine all hydrophilic polymers. This is not found persuasive because in addition to the fact that there is a serious burden to search different species that do not relate to a single inventive concept, that are classified in different subclasses according to the current US Classification, there is also nothing on the record to indicate that the species are not patentable distinct. It was noted in the previous office action, that if the applicants wish to traverse the election of species requirement (required for examination purposes only), on the grounds that the species are not patentable distinct, the applicants should submit evidence for the claimed species being of obvious variants. No such evidence has been presented or indicated.

The applicants response also alleges that the Examiner violates the statutory provisions of 35 USC 112 by issuing such election of species requirement. The applicants state that "Issuing a restriction requirement within a claim with the idea that Applicants would have to carve up that claim and pursue the nonelected subject matter in a separate application violates this right under section 112. Indeed, the C.C.P.A. has characterized such action as tantamount to a refusal to examine. See *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978)."

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However, it is noted that the Examiner did NOT require the carving up the invention, nor the Examiner refused examining of the claimed invention. In fact the previous Office action explicitly stated that "Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to *additional species* which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a)." (emphasis added) .

Therefore, the applicants arguments are, at best are misplaced and allegations are groundless.

It is noted that claims 48-49 and 50 are drawn to a non-elected species.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-46, 49, 51-55, 69-72, 81 -84 are rejected under 35 U.S.C.

103(a) as being unpatentable over US Patent 6,136,873 to Hahnle et al.,
(hereinafter "Hahnle '873").

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The reference discloses hydrogel composition comprising flexible plasticized hydrophilic polymer matrix that is obtained by polymerizing a foamed mixture of a polymerizable monomer, optionally with one or more comonomer. Among suitable polymerizable monomers, the species of 2-acrylamido-2-methylpropane sulphonic acid is expressly disclosed in column 3, line 14.

The reference discloses a process for preparing such hydrogels which process includes the steps of polymerizing the disclosed polymerizable monomers from the mixtures by placing foamed mixtures on a substrate and polymerizing the mixture. (See, for example, illustrative examples). The mixtures, in addition to the monomers, may include plasticizers, and gas bubbles that are introduced by high speed mixing of the mixtures or by additional introduction of gas bubbles by purging the mixture with inert gas.

The reference expressly discloses that inert gases are preferred, thus implying that other gases are also possible to employ. Since the claimed gas, air, is predominantly composed of inert (to free radicals) gases (nitrogen, carbon dioxide), its use would have been obvious for an ordinary artisan for at least the economic reasons with reasonable expectation of success and in the absence of showing of unexpected results that can be attributed to the use of air in place of disclosed nitrogen or other gases.

The reference further expressly discloses addition of a liquid composition containing post-foam crosslinkers (in a form of spray, for example) to the top of

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foamed and cured hydrogel sheet, with subsequent crosslinking. See, for example, column 13, last full paragraph.

The reference does not expressly disclose the structure of the resulting hydrogels, i.e., whether the hydrogels contain two distinct portions and their respective characteristics, such as thickness or cell void volume, etc. However, the reference discloses a method of obtaining the hydrogels which is substantially identical to the method disclosed in the instant specification, and from the compositions that are substantially identical to the compositions disclosed and claimed in the instant specification. It is specifically noted that the method disclosed in the reference expressly utilizes very high speeds of mixing the composition to obtain frothed compositions (as per examples – about 1000rpm), which fully correspond to the claimed speed, and which speed is indicated by the applicants as critical to obtain two portion composition.

Therefore, it is reasonably believed that the hydrogels disclosed in the references inherently and necessarily exhibit the claimed two portion structure with all the claimed characteristics, as obtained by substantially identical process and substantially identical compositions as disclosed in the instant specification.

The burden is shifted to the applicants to provide factual evidence to the contrary.

The invention as claimed, thus, is fully within the purview of the cited reference, and the choice of specific components from expressly disclosed

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components would have been an obvious choice of an ordinary artisan with reasonable expectation of success.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,241,713 discloses hydrogels obtained by foaming, by high speed mixing, and polymerizing hydrogel-forming polymers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

Irina S. Zemel
Primary Examiner
Art Unit 1796

ISZ